



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,342	12/12/2000	Gabriel V. Lechuga		5231

7590 10/21/2003
ROBERT J. SCHAAP
Suite 188
21241 Ventura Boulevard
Woodland Hills, CA 91364

EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
----------	--------------

3752

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,342

Applicant(s)

LECHUGA, GABRIEL V.

Examiner

James F. Hook

Art Unit

3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-21, 28-30 and 34-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

It is noted that the application has been revived, however, the examiner found incorrect information filed in the Declaration filed by Liliana Cancino which states "I do know that we have never received a copy of the **Advisory Office Action** (emphasis added) dated April 9, 2002, or the Notice of Abandonment." It should be noted that the office action allegedly not received was in fact a restriction requirement, and it is not clear from the remainder of the paper work filed for revival that the abandonment was never received. It is also noted that it is not clear whether the document sheets provided were sheets that are created as mail comes in or if they are only sheets that are made for when action is due, however, if such represent the received date of the paper there is no log for the month of April provided. If the paper were to have been received, it is highly likely it would not take 21 days for it to be received in the mail, and therefore the April sheet would be required to show such was never received. In order to make the file complete, if applicant's representative has a copy of the April log and can provide it with the next response, it would be appreciated to make the record clear that no paper was received in April which is when it would have been expected to be received, if the logs provided are actually created in the month the paper was received and are not just due date logs.

Election/Restrictions

Applicant's election with traverse of group I, species of figure 19 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the two groups are linked together, that the species of figure 19 must be used together with other embodiments,

Art Unit: 3752

and that all the claims read on the figure elected. This is not found persuasive because no linking claim was provided in paper 5, only remarks and it is clear there are no missing pages between the front page and the last page with the certificate of mailing following the applicants representative's signature, however it is noted that not all linking claims so link to different inventions and that such does not guarantee that the two inventions are the same. Therefore, without a proper linking claim present the two inventions are mutually exclusive, it is immaterial what the claimed invention was intended to be used for, if such is merely structure of a fastener which can be used for other purposes such is considered to be a separate invention, where it is known in the art that cloth can be held together by a straight pin which is a rigid structure and holds together less rigid material. Therefore, applicants election of figure 19 which deals with group I invention is elected and such is considered a proper restriction requirement. Likewise applicant even claims that other fasteners are used with the embodiments set forth in earlier claims, therefore it is clear that the sleeve structure of group I does not require the specific type of fastener set forth in group II. With respect to the election of figure 19 of group I, applicant has claimed the structures of the different figures separately thereby illustrating their understanding that such could be created, marketed and sold separately, and that one embodiment does not require the second embodiment to make it complete as seen in the breakdown of figures and the method in which the article is being claimed. It is also noted that the instant application does not claim J-traps or any other such structure merely pipes for hot water and insulation pieces used to cover them, and one could easily market and sell each piece exclusively

Art Unit: 3752

and would not require a complete set, as such is even suggested by the breakdown of the claims which only deal with specific embodiments in specific groups of claims. The claimed structure is directed to each sleeve alone, and the combination is directed toward the features of how two sleeves connect together not necessarily the sleeves of figure 1 and 12. It is noted that there is another application currently pending directed toward J-trap covers, and it is believed that such is considered mutually exclusive also since applicant filed two separate applications, the instant dealing with pipes for hot water, therefore all the arguments directed toward the use of J-trap and waste arm jackets combined is moot based on the claims of the instant application. It is noted that applicant may add claims at a later date, however the current restriction requirement can only be based upon the originally filed claims, and any attempt to vary the invention from that shown in elected species of figure 19 may be considered to fall under election by original presentation and not be addressed. With respect to the argument that other patents show the combination of the two sleeves, such is immaterial when those patents were filed with claims drawn to the combination of elements and would not be restrictable under normal practice, and also such cases may have been restricted in the same manner and based upon the allowance of a generic claim had the previously non-elected claims added back into the case before allowance. Such is not evidence that the sleeves must be used in combination as applicant suggests. It is also noted that figures 1 and 29 are in no way even close to the same species as set forth on page 7 by applicant, it is clear that the two species of figures 1 and 29 are use for different functions and are so designed for that use. Therefore, applicants arguments are not

Art Unit: 3752

persuasive and the election of species requirement stands. Applicant has elected figure 19, and states there are many generic claims, however, as set forth in the original restriction requirement no claim was considered generic, and therefore applicant is in error claiming that all the claims read on the elected species. Figure 19 fails to show any form of connector in the figures 19-21 which fall under the embodiment of figure 19, and therefore any claim positively reciting a connector in combination with the sleeve would not read upon figure 19. Figure 8 which is shown in the group including the embodiment of figure 1 clearly shows the claimed connector structure, and therefore would be linked to the claims which require such structure. Therefore, the only claims believed to be covered by figure 19 are claims 22-27 and 31-33 which deal with holes for connectors but aren't positively reciting structure of a connector, and these claims are the only claims believed to read on the elected species. The remaining claims 1-23, 28-30, and 34-35 are withdrawn from further consideration at this time, as drawn to a non-elected species which may be considered at a later date if the claims are considered generic and any allowable claim would also apply to non-elected species, and claims 36-38 are drawn to a non-elected invention. The following breakdown applies to the claim limitations required in the independent claim, or dependent claim which are not found in figure 19:

Claims 1-8 require a locking element not shown in figure 19;

Claims 9-12 require special structure of a fastener lock housing for two types of fasteners not shown in figure 19;

Claims 13-16 require fastener structure not found in figure 19;

Art Unit: 3752

Claims 17-21 require locking element not shown in figure 19;

Claims 28-30 require tapered portions not shown in the embodiment of figure 19;

Claims 34 and 35 require locking elements or fasteners not shown in figure 19;

Claims 36-38 are drawn to structure of connector not elected and also not shown in figure 19.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

It is noted that claim 35 has no period, and therefore does not constitute a full sentence and it is recommended that such be corrected in the next response.

Claim 27 recites the limitation "said protuberances" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Specification

The abstract of the disclosure is objected to because it is too long in length and is not directed to the structure of the article being claimed but rather also includes benefits and other recitations which are not directly related to the article and its intended use. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Art Unit: 3752

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 3752

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 31 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of copending Application No. 10/081,637. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure claimed in one is encompassed by the structure set forth in the other application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wendell. The patent to Wendell discloses the recited heat protective cover system for hot water pipes comprising a first jacket B capable of being wrapped about a portion of a pipe configuration having one end provided with a socket "b3" provided with an abutment flange therein, a second jacket provided just above jacket B in figure 1 also capable of being wrapped about another adjacent portion of the pipe configuration, the second jacket having an end portion sized to fit snugly within the socket of the first

Art Unit: 3752

jacket, where the end of the second sleeve engages the abutment flange in the first socket, there are longitudinal slots in the sleeves, a pair of holes in each side of the slot are provide which are opposite to one another and allow for the insertion of a fastener to lock the sleeves together which inherently would lock the socket around the end of the second jacket, and it is noted that fins C are also provided in the jackets.

Claims 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Helmsderfer (463). The patent to Helmsderfer discloses the recited jacket for disposition around a pipe which can carry hot water to prevent contact and injury comprising, a jacket 30 having an outer wall and formed of a flexible material which is bendable and capable of being wrapped around a pipe portion, a slit 40 in the jacket allows it to fit about the pipe where the resiliency of the material allows the jacket at the slit to come together, fins 44 are provided on the inner surface of the jacket and project inwardly to contact the pipe and are longitudinally arranged, where the fins are made of the same flexible material as the sleeve and therefore are considered to inherently to be flexible and capable to deflect, but has resiliency enough to hold the weight of the jacket on a section of pipe through frictional engagement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendell in view of Trueb (031). The patent to Wendell discloses all of the recited structure with the exception of forming a protuberance and recess of circular shape (where based upon the figures and understanding of the application such is meant to mean ring shaped around the end since the rounded protuberances shown are rounded only and not circular in shape, and this is the manner in which the examiner will treat this limitation). The patent to Trueb discloses that it's old and known to provide mating jackets around a pipe with rounded protuberances that extend in a ring like manner around the end of one section of portion 15, and interlock with recesses in the socket portion of jacket 12 to lock the two sleeve portions together. It would have been obvious to one skilled in the art to provide the sleeves of Wendell with a ring shaped rounded protuberance around one portion of the second sleeve to mate with a recess in the socket of the first jacket to further interlock the sleeves together and prevent separation as suggested by Trueb.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Walker, Trueb (730, 364, 669), Helmsderfer (566, 929, 413, 820) and Smith disclosing state of the art jackets for pipes, where Smith teaches using protuberances and recesses to interlock mating pipes.

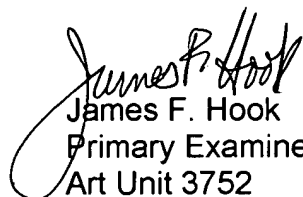
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (703) 308-

Art Unit: 3752

2913. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (703) 308-2087. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.


James F. Hook
Primary Examiner
Art Unit 3752

JFH